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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/755,966	01/12/2004	John Paul Helgeson	12854-41 (P03170US)	3588
81090	7590	11/16/2009	EXAMINER	
WARE/BHGL P.O. Box 10395 Chicago, IL 60610			IBRAHIM, MEDINA AHMED	
			ART UNIT	PAPER NUMBER
			1638	
			MAIL DATE	DELIVERY MODE
			11/16/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/755,966

**Applicant(s)**

HELGESON ET AL.

**Examiner**

Medina A. Ibrahim

**Art Unit**

1638

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) See Continuation Sheet is/are allowed.
- 6) ☒ Claim(s) 51-52, 54, 56, 58-60, 62-65, 75, 77, 79, 81-85 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 1,3,5-10,12-15,19-26,29-32,38-40,42-45,47-52,54,56,58-60,62-68,70,72 and 74-84.

Continuation of Disposition of Claims: Claims allowed are 1, 3, 5-10, 12-15, 19-26, 29-32, 38-40, 42-45, 47-50, 66-68, 70, and 72

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant's response filed 07/30/09 in reply to the Office action of 04/30/09 has been entered. Claims 1, 10, 13-14, 26, 38-39, 48, 51, and 56 are amended. New claims 74-84 are added. Therefore, claims 1, 3, 5-10, 12-15, 19-26, 29-32, 38-40, 42-45, 47-52, 54, 56, 58-60, 62-68, 70, 72, and 74-84 are pending and are examined.

All previous objections and rejections not set forth below have been withdrawn in view of Applicant's amendment to the claims and/or arguments.

#### ***Priority***

In the response filed 07/30/09, Applicant argues that SEQ ID NO: 4 is shown on page 69-71 and Example 6 at page 43-47 (referred as gene2) of the provisional application 60/439,376 ('376) filed 01/10/03. Applicant also argues that a sequence that is 100% identical to SEQ ID NO: 5 is disclosed at page 71 of the '376 parent application. Applicant therefore contends that the correct priority date of claims drawn to SEQ ID NO: 4 and 5 should be 01/10/03.

These arguments have been considered and found to be persuasive. Therefore, the effective filing date of claims 1, 3, 5-10, 12-15, 19-26, 29-32, 38-40, 42-45, 47-50, 66-68, 70, and 72, drawn to SEQ ID NO: 4 and 5, is considered to be 1/10/03.

However, claims drawn to 51-52, 54, 56, 58-60, and 82-85, drawn to promoter segment including SEQ ID NO: 23 effecting expression of RB genes; and claims 75, 77, 79, and 81, drawn to SEQ ID NO: 7 are not entitled to get the priority date of the

provisional application '376 because the sequences are not disclosed in the provisional application '376. Therefore, the filing date of claims 51-52, 54, 56, 58-60, 75, 77, 79, 81-85 are considered to be 01/12/04.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 62-65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 62 is indefinite for depending upon the cancelled claim 61. Dependent claims 63-65 are included in the rejection.

***Claim Rejections - 35 USC § 102***

1. Claims 62-65, 75, 77, 79, and 81 are rejected under 35 U.S.C. 102(e) as being anticipated by Allefs et al (US 20030221215A1, published 11/27/2003; effective filing date is 02/07/03). The effective filing of the rejected claims is 01/12/2004.
2. Claims 75, 77, 79, 81 are drawn to an isolated nucleic acid having 95% sequence identity to SEQ ID NO: 7 or a nucleic acid that hybridizes to SEQ ID NO: 7 under specified conditions and encoding a resistance polypeptide, and an expression cassette comprising said nucleic acid; said gene is from potato.
3. Allefs et al teach an isolated polynucleotide from potato that is 100% identical to Applicant's SEQ ID NO: 7 and encoding resistant polypeptide, a recombinant vector and expression cassette comprising said polynucleotide, and a method for providing

resistance against *Phytophthora infestans* by transforming the plant with said polynucleotide; transgenic *Solanaceae* plants including potato, tomato and progeny thereof having resistance to *Phytophthora*; said polynucleotide comprises an excisable label. Claims 62-65 are included in the rejection because they depend from cancelled claim 61 and are indefinite. Therefore, Allefs et al teach all claim limitations.

### ***Claim Rejections - 35 USC § 103***

Claims 51-52, 54, 56, 58-60, and 82-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aleffs et al (US 20030221215A1, published 11/27/2003). Applicant's arguments filed 11/25/08 have been fully considered but are not deemed persuasive.

4. Aleffs et al teach an isolated genomic DNA (see SEQ ID NO: 50) comprising a coding region having 100%% sequence identity to Applicant's SEQ ID NO: 7 and encoding a polypeptide that is 100% identical to Applicant's SEQ ID NO: 8, a recombinant vector and expression cassette comprising said polynucleotide, and a method of providing resistance against *Phytophthora infestans* by transforming the plant with said polynucleotide; transgenic *Solanaceae* plants including potato, tomato and progeny thereof having resistance to phytophthora. Allefs et al also teach a promoter region in SEQ ID NO: 50 that is 100% identical to Applicant's SEQ ID NO: 23. Allefs et al teach the sequence of SEQ ID NO: 50 is from potato
5. Aleffs et al do not teach an isolated promoter that controls the expression of the coding sequence of the RB genes. However, given the availability of the resistance

genomic DNA of SEQ ID NO: 50 containing its regulatory regions, and given the level of one of skill in the art, and the importance of resistance gene promoters as known to one of ordinary skill in the art, one would have been motivated to isolate the promoter sequence of the available resistance gene for use in plant transformation vectors to control expression of transcribable DNA sequences with a reasonable expectation of success.

***Remarks***

Claims 1, 3, 5-10, 12-15, 19-26, 29-32, 38-40, 42-45, 47-50, 66-68, 70, and 72 are allowable.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Medina A. Ibrahim whose telephone number is (571)272-0797. The examiner can normally be reached on M-TH 8:00 am to 5:30 PM, and every other Friday from 8:00 AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on 571-272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MAI  
11/10/2009

/Medina A Ibrahim/  
Primary Examiner, Art Unit 1638